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EXAMINER

RAMPURIA, SHARAD K

ART UNIT PAPER NUMBER

2683

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/891,592

Applicant(s)

STARKOVICH ET AL.

Examiner

Sharad K. Rampuria

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 11, 13-14, 16-21, & 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thakker in view of Johnson et al.

1. Regarding Claim 1, Thakker disclosed A method of transmitting a message from a portable communication device (120; fig.3; col.4; 7-31, col.5; 26-65) comprising:  
preparing the message to be transmitted; (140a; fig.3; col.4; 7-31, col.5; 26-65) and

Thakker fails to disclose transmitting the message from the portable communication device upon the occurrence of a user-defined event. However, Johnson teaches in an analogous art, that transmitting the message from the portable communication device upon the occurrence of a user defined event. (col.2; 23-35, col.3; 54-61) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include transmitting the message from the portable communication device upon the occurrence of a user defined event in order to provide information exchange with communication network based on user needs.

2. Regarding Claim 2, Thakker disclosed The method of claim 1, wherein transmitting the message includes transmitting the message from the portable communication device to a base station. (23; fig.3; col.4; 21-31)

3. Regarding Claim 3, Thakker disclosed all the particulars of the claim except the user defined event. However, Johnson teaches in an analogous art, that The method of claim 1, further comprising specifying the user defined event. (col.2; 23-35, col.3; 54-61) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event in order to provide information exchange with communication network based on user needs.

4. Regarding Claim 4, Thakker disclosed all the particulars of the claim except the user defined event includes specifying the date and time for transmission of the message. However, Johnson teaches in an analogous art, that The method of claim 3, wherein specifying the user defined event includes specifying the date and time for transmission of the message. (scheduling; col.2; 23-35, time intervals; col.3; 54-61) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event includes specifying the date and time for transmission of the message in order to provide information exchange with communication network based on user needs.

5. Regarding Claim 5, Thakker disclosed all the particulars of the claim except the user defined event includes specifying an acceptable cost level at which the message is to be sent. However, Johnson teaches in an analogous art, that The method of claim 3, wherein specifying the user defined event includes specifying an acceptable cost level at which the message is to be sent. (off-peak ...periods...economics; col.2; 23-35) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event includes specifying an acceptable cost level at which the message is to be sent in order to provide information exchange with communication network based on user's economic needs.

11. Regarding Claim 11, Thakker disclosed all the particulars of the claim except storing the message in memory in the portable communication device. However, Johnson teaches in an analogous art, that The method of claim 1, further comprising storing the message in memory in the portable communication device. (301; fig.3; col.6; 14-25) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include storing the message in memory in the portable communication device in order provide information exchange with communication network based on user profile saved in memory.

13. Regarding Claim 13, Thakker disclosed A method of transmitting a message to a portable communication device (120; fig.3; col.4; 7-31, col.5; 26-65) comprising:

Thakker fails to disclosed transmitting the message with a transmitter to the portable communication device upon occurrence of the transmission condition. However, Johnson teaches in an analogous art, that storing a message in memory; (301; fig.3; col.6; 14-25)

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defining a transmission condition for when the message is to be transmitted transmitting the message with a transmitter to the portable communication device upon occurrence of the transmission condition. (col.2; 23-35, col.3; 54-61) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include transmitting the message with a transmitter to the portable communication device upon occurrence of the transmission condition in order to provide information exchange with communication network based on user needs.

14. Regarding Claim 14, Thakker disclosed all the particulars of the claim except the defining a time when the message is to be transmitted. However, Johnson teaches in an analogous art, that The method of claim 13, wherein defining a transmission condition includes defining a time when the message is to be transmitted. (scheduling; col.2; 23-35, time intervals; col.3; 54-61) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the defining a time when the message is to be transmitted in order to provide information exchange with communication network based on user needs.

16. Regarding Claim 16, Thakker disclosed all the particulars of the claim except defining an acceptable quality of service level for when the message is to be transmitted. However, Johnson teaches in an analogous art, that The method of claim 13, wherein defining a transmission condition includes defining an acceptable quality of service level for when the message is to be transmitted. (network capacity; col.2; 23-35, col.7; 36-50) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event includes specifying an acceptable quality of service level at which the message is to be sent

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in order to provide information exchange with communication network based on user needs and network capacity.

17. Regarding Claim 17, Thakker disclosed all the particulars of the claim except defining an acceptable cost for when the message is to be transmitted. However, Johnson teaches in an analogous art, that The method of claim 13, wherein defining a transmission condition includes defining an acceptable cost for when the message is to be transmitted. (off-peak ...periods...economics; col.2; 23-35) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event includes specifying an acceptable cost for which the message is to be sent in order to provide information exchange with communication network based on user's economic needs.

18. Regarding Claim 18, Thakker disclosed The method of claim 13, further comprising receiving the message with an antennae on the portable communication device. (20; fig.3)

19. Regarding Claim 19, Thakker disclosed A portable communication device (120; fig.3; col.4; 7-31, col.5; 26-65) comprising:

a transmitter having an antennae to transmit the message; (20; fig.3) and

Thakker fails to disclosed transmit the message with the transmitter upon occurrence of a user defined event. However, Johnson teaches in an analogous art, that a memory to store a message; (301; fig.3; col.6; 14-25)

a processor, wherein the processor is adapted to transmit the message with the transmitter upon occurrence of a user defined event. (104; fig. 1; col.3; 28-41) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include transmit the message with the transmitter upon occurrence of a user defined event in order to provide information exchange with communication network based on user needs.

20. Regarding Claim 20, Thakker disclosed all the particulars of the claim except the user defined event. However, Johnson teaches in an analogous art, that The portable communication device of claim 19, where in the processor is further adapted to monitor the operation of the portable communication device and determine if the user defined event has occurred. (104; fig. 1; col.3; 28-41) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event in order to provide information exchange with communication network based on user needs.

21. Regarding Claim 21, Thakker disclosed all the particulars of the claim except the defining a time when the message is to be transmitted. However, Johnson teaches in an analogous art, that The portable communication device of claim 20, wherein the processor is further adapted to determine if a current time is substantially equal to a time specified as at least part of the user defined event. (scheduling; col.2; 23-35, time intervals; col.3; 54-61) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the defining a time when the message is to be transmitted in order to provide information exchange with communication network based on user needs.



23. Regarding Claim 23, Thakker disclosed all the particulars of the claim except defining an acceptable quality of service level for when the message is to be transmitted. However, Johnson teaches in an analogous art, that The portable communication device of claim 20, wherein the processor is further adapted to determine if a current quality of service level is substantially equal to an acceptable quality of service level specified as at least part of the user defined event. (network capacity; col.2; 23-35, col.7; 36-50) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event includes specifying an acceptable quality of service level at which the message is to be sent in order to provide information exchange with communication network based on user needs and network capacity.

24. Regarding Claim 24, Thakker disclosed An article (120; fig.3; col.4; 7-31) comprising: preparing a message to be transmitted by a portable communication device; (20; fig.3; col.5; 26-65) and

Thakker fails to disclosed transmit the message with the transmitter upon occurrence of a user defined event. However, Johnson teaches in an analogous art, that a storage medium having stored thereon instructions, that, when executed by a computing platform, results in; (301; fig.3; col.6; 14-25)

transmitting the message from the portable communication device upon the occurrence of a user defined event. (104; fig.1; col.3; 28-41) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include transmit the message with the

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transmitter upon occurrence of a user defined event in order to provide information exchange with communication network based on user needs.

25. Regarding Claim 25, Thakker disclosed The article of claim 24, wherein the instructions, when executed, further result in transmitting the message from the portable communication device to a base station. (23; fig.3; col.4; 21-31)

26. Regarding Claim 26, Thakker disclosed all the particulars of the claim except the user defined event. However, Johnson teaches in an analogous art, that The article of claim 24, further comprising specifying the user defined event. (col.2; 23-35, col.3; 54-61) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event in order to provide information exchange with communication network based on user needs.

27. Regarding Claim 27, Thakker disclosed all the particulars of the claim except defining an acceptable quality of service level for when the message is to be transmitted. However, Johnson teaches in an analogous art, that The article of claim 26, wherein defining a transmission condition includes specifying an acceptable quality of service level for when the message is to be transmitted. (network capacity; col.2; 23-35, col.7; 36-50) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event includes specifying an acceptable quality of service level at which the message is to be sent

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in order to provide information exchange with communication network based on user needs and network capacity.

28. Regarding Claim 28, Thakker disclosed all the particulars of the claim except defining an acceptable level of service level for when the message is to be transmitted. However, Johnson teaches in an analogous art, that The article of claim 26, wherein the instructions, when executed, further result in specifying an acceptable level of service level at which the message is to be transmitted. (network capacity; col.2; 23-35, col.7; 36-50) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event includes specifying an acceptable level of service level at which the message is to be sent in order to provide information exchange with communication network based on user needs and network capacity.

Claims 7, 15 & 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thakker & Johnson et al. further in view of Lazaridis et al.

7. Regarding Claim 7, The above combination disclosed all the particulars of the claim except the user defined event includes specifying an acceptable security level at which the message is to be sent. However, Lazaridis teaches in an analogous art, that The method of claim 3, wherein specifying the user defined event includes specifying an acceptable security level at which the message is to be sent. (encrypted; col.4; 16-25) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event includes

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specifying an acceptable security level at which the message is to be sent in order to provides for secure delivery of user-selected data items from the host system to mobile device.

15. Regarding Claim 15, The above combination disclosed all the particulars of the claim except the user defined event includes specifying an acceptable security level at which the message is to be sent. However, Lazaridis teaches in an analogous art, that The method of claim 13, wherein defining a transmission condition includes defining an acceptable security level for when the message is to be transmitted. (encrypted; col.4; 16-25) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event includes specifying an acceptable security level at which the message is to be sent in order to provides for secure delivery of user-selected data items from the host system to mobile device.

22. Regarding Claim 22, The above combination disclosed all the particulars of the claim except the user defined event includes specifying an acceptable security level at which the message is to be sent. However, Lazaridis teaches in an analogous art, that The portable communication device of claim 20, wherein the processor is further adapted to determine if a current system security level is substantially equal to an acceptable security level specified as at least part of the user defined event. (encrypted; col.4; 16-25) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event includes specifying an acceptable security level at which the message is to be sent in order to provides for secure delivery of user-selected data items from the host system to mobile device.

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Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thakker & Johnson et al. further in view of Uchiyama.

9. Regarding Claim 9, The above combination disclosed all the particulars of the claim except the portable communication device is coupled to a stable power supply. However, Uchiyama teaches in an analogous art, that The method of claim 1, further comprising compressing the message only when the portable communication device is coupled to a stable power supply. (pg.6; 0051) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to the portable communication device is coupled to a stable power supply in order to provide docking station for stable power.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thakker & Johnson et al. further in view of Lele et al.

10. Regarding Claim 10, The above combination disclosed all the particulars of the claim except transmitting the message includes wirelessly transmitting the message to a receiver and disabling a ringing function of the receiver. However, Lele teaches in an analogous art, that The method of claim 1, wherein transmitting the message includes wirelessly transmitting the message to a receiver and disabling a ringing function of the receiver. (col.6; 56-col.7; 44) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include transmitting the message includes wirelessly transmitting the message to a receiver and disabling a ringing function of the receiver in order to determine operational status thereof.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thakker & Johnson et al. further in view of Rutledge.

12. Regarding Claim 12, The above combination disclosed all the particulars of the claim except storing the message in non-volatile memory. However, Rutledge teaches in an analogous art, that The method of claim 11, wherein storing the message in memory includes storing the message in non-volatile memory. (col.3; 19-29) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include storing the message in non-volatile memory in order to tactile proximity when retrieving messages.

Claims 6, & 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thakker & Johnson et al. further in view of Haartsen et al.

6. Regarding Claim 6, The above combination disclosed all the particulars of the claim except the user defined event includes specifying an acceptable transmission power level at which the message is to be sent. However, Haartsen teaches in an analogous art, that The method of claim 3, wherein specifying the user defined event includes specifying an acceptable transmission power level at which the message is to be sent. (power level; col.6; 50-65) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event includes specifying an acceptable transmission power level at which the message is to be sent in order provide transmission power control method in achieving the target.

8. Regarding Claim 8, The above combination disclosed all the particulars of the claim except the user defined event includes specifying an acceptable distance from a base station at which the message is to be sent. However, Haartsen teaches in an analogous art, that The method of claim 3, wherein specifying the user defined event includes specifying an acceptable distance from a base station at which the message is to be sent. (distance; col.6; 50-65) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event includes specifying an acceptable distance from a base station at which the message is to be sent in order to provide transmission power control method in achieving the target.

***Applicant's arguments filed on 4/29/2004 have been considered but they are not persuasive.***

Applicant respectfully disagrees about the cited passage in the given references. However, the determination of obviousness is still based upon the Johnson's references as follows.

Regarding claims 1, 13, 19, & 24, applicant argues that Thakker & Johnson et al. do not teach a user-defined event. In response, Johnson et al. teaches the user-defined time intervals, (col.3; 54-61) which merely cites a user-defined event. Further, applicant argues that the user does not control the user-defined event; this aspect is not recite in the claim.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharad Rampuria whose telephone number is 703-308-4736.

The examiner can normally be reached on Mon-Fri. (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703-308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Sharad Rampuria  
July 1, 2004



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